

Serial # 10/528,168
Attorney Docket No: EX03-065C-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Francis-Lang et al

Serial No.: 10/528,168 ✓
Int'l App. No: PCT/US03/28903

Filed: 3/16/2005

For: FLJ20647S AS MODIFIERS OF THE
P21 PATHWAY AND METHODS OF
USE

Group Art Unit:

Examiner:

Confirmation No: 3479

Attorney Docket No: EX03-065C-US

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

Commissioner of Patents
Alexandria, VA 22313-1450

The notification of missing requirements under 35 USC 371 for the above-identified application (copy attached), mailed 7/29/2005, states that the declaration for application does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. Applicants respectfully disagree.

After careful review of the requirements of 37 CFR 1.497(a) and (b), 37 CFR 1.66, and 37 CFR 1.68, applicants believe the submitted declaration of inventors, a copy of which is attached hereto, fully meets the requirements of the above rules. Applicants notice that the requisite fee for the submission of declaration was not filed along with the declaration, and the fee is submitted along with this response. To expedite matters and clarify the requirements of acceptance with USPTO, applicants have made numerous attempts to contact the office, via telephone on 8/11/05, 8/12/05, 8/18/05, and 8/24/05, and via facsimile on 8/25/05, and 9/2/05. Copy of the notes for the phone contacts, and the fax communications are also attached. Applicants hereby respectfully request the office personnel to clarify exactly which requirement of the above rules is missing from the applicants' submissions.

This is responsive to the notification mailed 7/29/2005. The Commissioner is authorized to charge the requisite fee for submission of the declaration, and any other

Serial # 10/528,168

Attorney Docket No: EX03-065C-US

fees required for consideration of this paper and any other papers filed herewith to
deposit account number 50-1108.

Respectfully submitted,

Dated: September 22, 2005



Laleh Shayesteh Reg. No. 47,937

EXELIXIS, INC.

170 Harbor Way, P.O. Box 511

South San Francisco, California 94083-0511

Telephone: (650) 837-8223

Facsimile: (650) 837-8234

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130

Complete if Known

Application Number 10/528,168

Filing Date 3/16/2005

First Named Inventor Francis-Lang

Examiner Name

Art Unit

Attorney Docket No. EX03-065C-US

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 50-1108

Deposit Account Name 50-1108

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or any underpayment of fee(s)
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid	
-20 **		= 0		X		= 0	
Independent Claims		-3 **		= 0		X	
Multiple Dependent				X		= 0	

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ 0

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	130.00
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2,080	2255	1,040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	2503	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) /03/2005 LLANDGRA 00000021 501108 1052816

*Reduced by Basic Filing Fee Paid

130.00 DA

SUBTOTAL (3) (\$ 130

**or number previously paid, if greater; For Reissues, see above

SUBMITTED BY

Name (Print/Type) Laleh Shayesteh

Registration No. (Attorney/Agent) 47,937

Telephone 650 837-8223

Signature

Date

September 22, 2005

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

8-11-05

Cancelled Padua
Booker at PTO 8/12
re: Declaration
10/528,168 - EX03-0650-45
left message

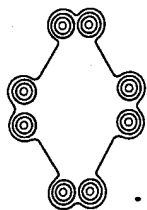
8-18-05 8:45 AM

followed up -
left another
message

8-24

8:12

left another
message



EXELIXISTM

Facsimile Cover Sheet

Date: August 25, 2005

To: Patricia Booker

From: Luajuana LeGrande

Company: USPTO - Assignment Div.

Phone: 650-837-7231

Fax: 703-746-6695

Fax: 650-837-8234

Subject: Serial No. 10/528,168 - Declaration

Total number of pages including cover sheet: 17

Attached is a copy of the Declaration in question.

Thank you for your assistance in this matter.

Thanks,
Luajuana

9-2-05

3 pgs

Ms. Booker.

Please provide status
on this case
Thank you
Luajuana.

CONFIDENTIALITY NOTE:

The information contained in this facsimile transmission is intended only for the use of the addressee and may contain information that is confidential, privileged or otherwise exempt from disclosure under applicable law. If you are not the intended recipient, you are hereby notified that any dissemination, distribution or reproduction of this transmission is strictly prohibited. If you have received this transmission in error, please notify the sender by telephone and return the original message to the above via the U.S. Postal Service. Thank you.

MODE = MEMORY TRANSMISSION

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END=AUG-25 10:29

FILE NO.= 111

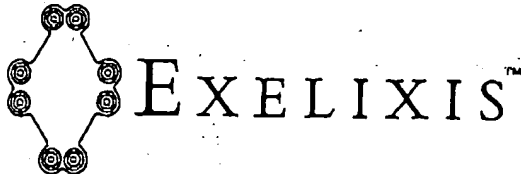
STN NO..	COM	ABBR NO.	STATION NAME/TEL.NO.	PAGES	DURATION
001	OK	S	917037466695	017/017	00:05'06"

-EXELIXIS

***** -

- ***** -

650 837 8234- *****



Facsimile Cover Sheet

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MODE = MEMORY TRANSMISSION

START=SEP-02 12:13

END=SEP-02 12:14

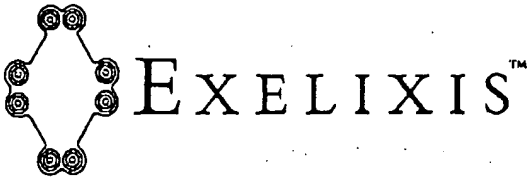
FILE NO. = 144

STN NO.	COM	ABBR NO.	STATION NAME/TEL.NO.	PAGES	DURATION
001	OK	S	917037466695	003/003	00:00'54"

-EXELIXIS

- ***** -

650 837 8234- *****



Facsimile Cover Sheet

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Attached is a copy of the Declaration in question.

Thank you for your assistance in this matter.

Thanks,
Luajuana

9-2-05

*Mr Booker
is pending Case &
will inform us after
review.
3 pgs*

Ms. Booker.

*Please provide status
on this case
Thank you
Luajuana.*

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/528,168	Helen Francis-Lang	EX03-065C-US

23500
 PATENT DEPT
 EXELIXIS, INC.
 170 HARBOR WAY
 P.O. BOX 511
 SOUTH SAN FRANCISCO, CA 94083-0511

INTERNATIONAL APPLICATION NO.

PCT/US03/28903

LA. FILING DATE

PRIORITY DATE

09/15/2003

CONFIRMATION NO. 3479

371 FORMALITIES LETTER



OC00000001665535

Date Mailed: 07/29/2005

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 03/16/2005
- Copy of the International Search Report filed on 03/16/2005
- Information Disclosure Statements filed on 04/25/2005
- Biochemical Sequence Diskette filed on 03/16/2005
- Oath or Declaration filed on 03/16/2005
- Biochemical Sequence Listing filed on 03/16/2005
- Request for Immediate Examination filed on 03/16/2005
- U.S. Basic National Fees filed on 03/16/2005

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

DOCKETED
Exelixis, Inc.

*A copy of this notice **MUST** be returned with the response.*

PATRICIA A BOOKER

Telephone: (703) 308-9140 EXT 204

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/528,168	PCT/US03/28903	EX03-065C-US

FORM PCT/DO/EO/905 (371 Formalities Notice)



TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/528,168	
	Filing Date	3/16/2005	
	First Named Inventor	Francis-Lang	
	Art Unit		
	Examiner Name		
Total Number of Pages in This Submission	27	Attorney Docket Number	EX03-065C-US

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input checked="" type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Copy of notice of missing parts Copy of declaration papers Copies of phone and fax communications Return Receipt Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	EXELIXIS, INC.		
Signature			
Printed Name	Laleh Shayesteh		
Date	September 22, 2005	Reg. No.	47,937

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Laleh Shayesteh	Date	September 22, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.